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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,246	08/20/2003	Gary Hochman	0813-017P/JAB	6059

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SCHWEITZER CORNMAN GROSS & BONDELL LLP
292 MADISON AVENUE - 19th FLOOR
NEW YORK, NY 10017

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/644,246	HOCHMAN, GARY	
	Examiner	Art Unit	
	Saeid Ebrahimi-dehKordy	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/20/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1,4,10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Hochman (U.S. patent 5,838,685)

Regarding claims 1 and 10 Hochman teaches: A method for the transmission of image data from a sender to a recipient, comprising the steps of inserting at the location of the sender into a data transmission including an image format portion data identifying the address of the intended recipient of the image-format portion of the transmission and message tracking data (please note Fig.5 column 5 lines 9-15 where Hochman teaches the insertion of the recipient's email address while tracking the message data through the handshaking technique) transmitting the data transmission over a

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transmission system from the sender's location to an intermediate point of presence facility (please note Fig.5 column 5 lines 35-43 where the sending facsimile machine sends the fax to the receiving facsimile) and receiving the data transmission by the point of presence facility and re-transmitting the data comprising the image portion to the identified address of the recipient (please note Fig.5 column 5 lines 44-55 where the email transmission is prepared and send is step 12 of Fig.5).

Regarding claim 4 Hochman et al teaches The method of claim 3 including the further step of stripping the message tracking data from the data transmission at the point of presence facility before retransmission (please note column 5 lines 47-48).

Regarding claim 11 Hochman discloses: The method of claim 10 wherein the identified address of the recipient is a telephone number associated with a facsimile reception apparatus and said re-transmission includes a portion over a telephone line linked to the facsimile reception apparatus (please note Fig.5 items 100 to 106 column 5 lines 15-43).

Regarding claim 12 Hochman teaches The method of claim 10 wherein the transmission from the sender to the point of presence Facility is in the form of an e-mail transmission (please note column 5 lines 47-50).

Regarding claim 13 Hochman discloses: The method of claim1 wherein the step of transmitting the data transmission over a telephone system from the sender's location to an intermediate point of presence facility include converting the image data to facsimile format and transmitting the image data in the facsimile format (please note

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abstract where Hochman et al teach the chosen format to be transmitted to the presence facility).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3,5,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochman (U.S. patent 5,838,685) in view of Denker (U.S. patent 6,404,513)

Regarding claim 2 and 14 Hochman does not quite teach, The method of claim 1 wherein the message tracking data inserted comprises at least one of accounting , audit and documentation data. On the other hand Denker teaches The method of claim 1 wherein the message tracking data inserted comprises at least one of accounting , audit and documentation data (please note column 3 lines 1-4 where the messages being tracked, also note column 2 lines 55-67).). Therefore it would have been obvious for one of ordinary skill in the art to modify the teaching of Hochman et al by tracking the message delivery of the facsimile such as taught by Denker

Regarding claim 3 Denker teaches The method of claim 2 further including the step of processing the message tracking data by the point of presence facility (please note column 4 lines 66-67 and column 5 lines 1-12).

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Regarding claim 5 Denker further teaches The method of claim 1 further including the steps of: inserting at the location of the sender into the data transmission data identifying an address of the sender; and sending a confirmation message to the sender's address by the point of presence facility after re-transmitting the data comprising the image portion to the recipient's identified address (please note column 4 lines 1-6 and column 5 lines 9-12).

Regarding claim 8 Denker teaches The method of claim 6, wherein the address of the sender is an e-mail address and the step of sending a confirmation message includes forwarding an e-mail message to the sender's e-mail address (please note column 6 lines 55-56).

Regarding claim 9 Denker discloses: The method of claim 1 further Including the steps of generating a confirmation message by the point of presence Facility after re-transmitting the data comprising the image Portion to the recipient's identified address and allowing the sender access to the confirmation message (please note Fig.2 item 44 column 4 lines 59-65 where the conformation message was send to the sender).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 6-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Hchman (U.S. patent 5,838,685) in view of Denker (U.S. patent 6,404,513) and further in view of Bloomfield (U.S. patent 6,025,931)

Neither Hochman nor Denker teach or suggest an address of the recipient being an email address and forwarding the data as an email attachment to the recipient's email address, as recited in the claims 6 and 7 this limitation however is taught by Bloomfield (column 6 lines 47-65) such the limitation enables a recipient to receive the image data either at his or her computer or a receiving facsimile terminal, thereby enhancing versatility. Thus it would have been obvious for one of ordinary skill in the art to modify the combined teachings of Denker and Hochman et al by providing for email reception of image data as taught by Hochman et al.

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (571) 272-7462.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

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(571) 273-8300, (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

Or:

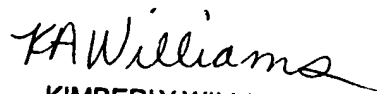
(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Knox building on 501 Dulany
Street, Alexandria, VA.

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2626
September 15, 2005




KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER R